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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/651,562	05/22/96	ROBERTS M	9329001C0E

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EXAMINER	
HO, T	
ART UNIT	PAPER NUMBER
2604	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/651,562	Applicant(s) Roberts et al
	Examiner T. Ho	Group Art Unit 2604

☒ Responsive to communication(s) filed on *9/16/96 and 1/31/97* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *47-104* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) *47-61* is/are allowed.

☒ Claim(s) *62-104* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 47-104 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 5,138,459 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "output data control means" and "logic means" in claims 47 and 56, steps of storing, formatting and storing the formatted digitized version in a memory in claim 62, memory, format determining means in claim 66, steps of retrieving, storing in claim 69, input interface, converter output interface, stored program controller in claim 72, input interface, converter, output interface controller in claim 75, steps of reading, converting, determining, formatting in claims 79 and 80, output data file format determining means, logic means for removably mounting a

digital memory in claim 82, input interface, converter, generator, output data file format determining means, logic means, and output interface in claim 84, optic lens, shutter means, array, analog to digital converter memory means output data control means, and logic means in claim 88, input means, means for converting, means for providing and means for formatting in claim 96, digital data format means, and means for formatting in claim 99, and converting the captured analog signal data, arranging the digital image data in claim 104 . In addition, 1) claims 1-8 of U.S. Patent'459 recite the term "comprising" and 2) the electronic still video camera is shown in Figs. 2 and 10, which includes all the limitation of the claims 1-18 of U.S. Patent'459 and claims 47-104 of the present application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. Claims 56-61, 62-65, 66-68, 69-71, 79, 80-81, 82 and 83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since the term "comprising" is not recited in the preamble, it is not clear how the preamble of claims 66 and 82 is referred to claimed limitations in the claim body.

Claims 56, 62, 69, 79, 80 and 83 are not clear since the claims recite a method claim without steps.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 62-67, 69, 70, 72-75, 79-88, 90, 91, 93 and 96-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakai.

With regard to claim 66, Sakai discloses in Fig. 3, the same image data capturing and processing device capable of generating a digitized version of a captured image (a still video camera in Figs. 5 and 6), memory for storing format data defining a file format for use by a computer program (interface line driver 175 inherently includes a memory which stores format data defining an output file format for RAM 173 corresponding to a personal computer 63), and format determining means for retrieving the format data from the memory , for selectively arranging the digitized version of the captured image and the format data into the defined file format, and for storing the formatted digitized image file contents in an image memory element (digital signal processing circuit 177 and operation switch 167 control the interface driver 175 to convert image data from RAM 173 to a formatted output file contents corresponding to the

computer 63, and the formatted output is stored in the computer disk) as specified in claim 66; means for checking format status of the image memory element (digital signal processing circuit 177) as specified in claim 67; claims 62 and 63 recite what was discussed with respect to claim 66 and 67; digital memory and memory element (computer disk is shown in the computer 63) as specified in claims 64 and 65; the steps of retaining an indication of a preselected output data file format (interface driver 175 stores format code data), retrieving the indication and formatting the digitized version in accordance with the retrieved indication (digital signal processing circuity 177 retrieving the digitized data from the RAM 173 and controls the interface driver 175 to convert the data into a formatted data corresponding a personal computer 63), and storing the formatted digital version in a digital memory element capable of being coupled to an information handling device having a program utilizing the preselected output data file format (computer 63 stores the formatted data after receiving the data from the interface 175 under a control of digital processing circuits 177 and operation switch 167) as specified in claim 69; after retrieving the indication, checking the format of the digital memory element for agreement with the preselected format and automatically performing format initialization of the digital memory element (digital processing circuit 177) as specified in claim 70; input interface (FM demodulation circuit 153), converter (A/D converter 171), output interface (interface line driver 175), stored program controller (digital signal processing circuit 177 and operation switch 167) as specified in claims 72 and 73; input interface can removably receive a first memory element comprising an analog video memory element, the output interface can removably receive a second memory element

comprising a digital memory element and the converter including an analog to digital converter (disk 23, RAM 173 and A/D converter 171) as specified in claim 74; claim 75 recites what was discussed with respect to claim 72; claims 79, 80 and 81 recite what was discussed with respect to claims 72 and 73; generator (digital signal processing circuit 177) as specified in claim 82; claims 83-87 recite what was discussed wit respect to claims 72 and 73; optical lens (lens unit of the video camera in Fig. 5), shutter (a shutter means used to control an exposure of the camera is inherently included in the camera in Fig. 5), array of discrete light sensing pixel elements (image device 131), A/D converter means (A/D converter 171), memory means (RAM 173), output data control means (processing circuit 177 working in conjunction with interface line driver 175 controls the format conversion), and logic means digital processing circuit 177) as specified in claim 88; digital data means (RAM 171) as specified in claim 90; memory organizing means (digital signal processing circuit 177) as specified in claim 91; memory allocating means (digital signa processing circuit 1770 as specified in claim 93; claims 96-98 recites what was discussed with respect to claims 72 and 73; and claim 99-101 recites what discussed with respect to claims 56-58; and claims 102-104 recite what was discussed with respect to claims 47-49.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 76, 77 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai.

With regard to claims 76, 77 and 78, Sakai discloses substantially the same subject matter claimed in claim 75, except for the first electrical signal representation comprising NTSC format (in claim 76), PAL format (in claim 77) and RGB format (in claim 78).

Although Sakai does not explicitly disclose the image signals of the camera in Fig. 5, which comprises NTSC, PAL or RGB video format, these format are standard in television systems; and in order to display a video image on a standard video set, a video camera needs to produce a video signal which is in the standard system such as NTSC, PAL or RGB video format.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement the NTSC, PAL or RGB video format of a standard video system in the video signals of the Sakai camera in order to display the video image on a normal TV set because the implementation of the NTSC, PAL or RGB video format in the video signal of Sakai would maximize the camera performance in Sakai.

5. Claims 68, 71, 89, 92, 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai in view of Watanabe et al.

Sakai discloses substantially the same subject matter claimed in claim 66, 69 and 88, except for means for compressing the digitized version of the captured image before the digitized version is formatted by selectively utilizing one of a plurality of predetermined compression algorithm parameters and means for storing in the image data memory element a signal to signify which of the plurality of compression algorithm parameters are associated with the compression digitized version of a captured image.

Although Sakai does not explicitly disclose the compression means and means for storing a plurality of compression algorithm parameters, the use of a plurality of compression ratios to compress an video signal is old and well known in the art. Furthermore, Watanabe et al teaches in Fig. 1 a digital electronic still camera which includes orthogonal transform circuit 24, encoder 26 and LUT 38; wherein the circuits compress the image signal in accordance with one of a compression ratios stored in the LUT 38 so as to obtain a desired image quality corresponding to a compression ratio, and economically one camera circuit which is able to perform a plurality of compression ratios (col. 1, lines 53-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement the orthogonal transform circuit 24, encoder 26 and LUT 38 of Watanabe et al in the camera circuit of Sakai, so as to perform different compression ratios on an image signal and store the compression ratios in a memory (LUT 38) because the implementation of the circuits of Watanabe et al in the camera circuit of Sakai would maximize the camera performance in Sakai as specified in claims 68, 71, 89 and 94.

With regard to claim 92 , claimed marking means for recording a unique mark indicating decompression algorithm parameters to be utilized in decompressing the digital data information signals is met by encoder 26; wherein the encoder provide a signal together with a compressed image signal so as recorded in memory 32 (lines 48-53).

With regard to claim 95, claim 95 recites what was discussed with respect to claim 92.

6. Claims 47-61 are allowed.

The prior art of record fails to suggest or disclose an image capturing and processing device including means for digitizing captured image data and a memory element for storing digitized image data , the improvement comprising output data control means for selecting one of a plurality of different output data format codes stored in the image data capturing and processing device, each output data format code to be associated with each digitized captured image to be stored in the memory element and corresponding respectively to one of a like plurality of different data formats for different types of computer apparatus, and logic means responsive to the output data control means for determining an output data format for a digitized captured image in accordance with a selected one of the plurality of different output data format codes in claim 47; and an image data capturing and processing device comprises means for capturing, means for digitizing, removable mounted memory means, wherein output data format control means for storing in the device at least one of a plurality of different output data format codes where each of the plurality of output data format codes corresponds respectively to one of a like

plurality of different data formats for different types of computer apparatus; and logic means responsive to the format control means for selectively controlling the formatting of the digitized captured image data in accordance with a selected one of the plurality of different output data codes in claim 56.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Ho whose telephone number is (703) 305-4943. The examiner can normally be reached on Mon-Fri from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. Faile, can be reached on (703) 305-4380. The fax phone number for this Group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
GROUP 2600

T. Ho

Patent Examiner

April 24, 1997